

09/650,481

MS155614.1

REMARKS

Claims 1-26 are currently pending in the subject application and are presently under consideration. A version of all pending claims is found on pages 2-5. Claim 7 has been amended herein to correct a minor informality. Applicants' representative thanks the Examiner for renumbering claims 24-25 to bring them within ambit of 37 C.F.R. §1.126 - claims 24-26 have therefore been renumbered herein in accordance with Examiner's amendment.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1-4, 7-9, 13, 16, 18-19, 20-23, 25-26 Under 35 U.S.C. §102(e)**

Claims 1-4, 7-9, 13, 16, 18-19, 20-23, 25-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hirata (U.S. Patent No. 6,374,406). Withdrawal of this rejection is requested for at least the following reasons. Hirata does not disclose or suggest each and every limitation of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites: *a token having a schema that identifies a corresponding program so that a recording system receiving the token is programmable to record the program based on the token*. Independent claims 8, 16, 20, and 22 recite similar limitations. Hirata neither discloses nor suggests such features of applicants' claimed invention.

09/650,481

MS155614.1

The claimed invention relates to a system and method for *identifying* audio and/or visual programs to be recorded through novel employment of *tokens associated with audio and/or visual programs*. In particular, the claimed invention employs a token and schema in connection with *identifying a corresponding program so that a recording system receiving the token with unique schema is programmable to record the program based on the token*. A token in accordance with an aspect of the subject invention includes a multi-level data structure containing a plurality of fields for holding different types of data, that not only identifies pertinent program information for a corresponding segment of broadcast audio and/or visual information so as to enable a token enabled recording device to add the program criteria to a program list for recording at a future date and time, but also allows tokens to be tracked through a token global unique identifier (GUID). The token can also provide a plethora of important ancillary information regarding the selected program and mode of broadcast, e.g., Direct Satellite Systems ("DSS"), Advanced Television ("ATV") systems, Digital Television ("DTV") systems, Video-on-Demand, MPEG over ATM Networks, High Definition Television ("HDTV") and cable, to name but a few. Further, regarding claims 2 and 3, the disclosed token schema is transportable between token enabled devices - electronic mail is merely one illustrative means for communicating/transporting token information; other communication/transportation means, such as Internet Protocol and TCP/IP, can be utilized to transport tokens between networked devices. It is respectfully submitted that Hirata neither discloses nor suggests the token and schema of the claimed invention let alone the various novel functionalities associated therewith.

On the other hand, Hirata teaches provision and extraction of control command via e-mail that facilitates programming household appliances to perform a set of factory predetermined tasks. See e.g., column 10, lines 49-54. Hirata provides for remotely transmitting (e.g., e-mail) commands in connection with programming/controlling hardware. The control commands provide for performing rudimentary operations such as "start recording on 10-th day (date, 11:00 (FROM) to 12:00 (TO), at SP (Standard Play) SPEED" is set. Thus, Hirata merely teaches sending commands regarding what device to operate, when to start and when to end, for example. There is no context or information

09/650,481

MS155614.1

provided regarding what is in fact being recorded let alone employment of information about what is desired to be recorded to facilitate recording thereof as in applicants' claimed invention. More particularly, there is no teaching or suggestion in Hirata of providing information (*via* a token and schema) that includes program criteria for identifying a corresponding audio and/or visual program, which is sufficient to enable a recording system that receives the token to record the identified program based on the token as in the claimed invention. Moreover, Hirata does not disclose or suggest a structure/schema for such tokens. It is readily apparent that Hirata, neither discloses nor suggests applicants' claimed invention, and this rejection should be withdrawn.

**II. Rejection of Claims 5-6, 10-12, 14-15, 17, 24 Under 35 U.S.C. §103(a)**

Claims 5-6, 10-12, 14-15, 17, 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirata. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Hirata neither teaches nor suggests applicants' claimed invention, and furthermore it is clear that the teachings of Hirata do not motivate one skilled in the art to do that what applicants have claimed. It appears the subject rejection is impermissibly based on employment of applicants' specification as a 20/20 hindsight-based road map to achieve the purported invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a

09/650,481

MS155614.1

patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

As discussed *supra* with respect to independent claims 1, 8, 16, 20 and 22, Hirata does not make obvious the utilization of a token mechanism and schema to facilitate identification of pertinent program information, nor does Hirata make obvious communicating the aforementioned tokens to other token enabled networked devices through a network communication medium. Moreover, since Hirata alone does not disclose utilizing tokens to convey information between token enabled devices, nor does Hirata teach or suggest a schema for embodying pertinent video and/or audio program information, there is no motivation to utilize Hirata to deduce applicants' disclosure.

The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Black Drug*, 786 F.2d at 1143 n.5., 229 USPQ at 187 n.4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

Since Hirata is primarily concerned with using electronic mail messages to actuate household appliances to perform a set of factory predetermined tasks, the desirability of token schemas embodying a plurality of fields identifying pertinent program information corresponding to a broadcast segment, would not have been obvious from Hirata without independent suggestion as provided by applicants' disclosure. Since Hirata alone does not disclose, suggest nor teach, the utilization of tokens or a schema for identifying token information, there is no proper and acceptable basis for this rejection

09/650,481

MS155614.1

under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested or taught in the art but rather on advantages disclosed in the applicants' specification. This sort of rationale has been condemned by the CAFC as being sophistic; see e.g. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the forgoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established against applicants' claimed invention, and this rejection should be withdrawn.

#### CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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